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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,962	09/16/2003	Benedikt Sas	4532680/10280 (KEM 79)	2688

26386 7590 01/13/2006

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THE FINANCIAL CENTER  
666 WALNUT STREET  
SUITE 2500  
DES MOINES, IA 50309-3993

EXAMINER
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CHANG, CELIA C

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/663,962

Applicant(s)

SAS ET AL.

Examiner

Celia Chang

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Amendment and response filed by applicants dated Aug. 10, 2005 have been entered and considered carefully. Claims 1-6 and newly added claim 7 are pending.
2. The rejection of claim 4 under 35 USC 112 second paragraph is dropped in view of the amendment to the claim.
3. The rejection of claims 1-3 and 5 under 35 USC 112 first paragraph for lacking reasonable enablement for the claims are now applicable to the newly amended and added claims 1-7 for the same reason of record.

The claims are drawn to method of treating herpesvirinae employing compounds of formula in claim 1 wherein X<sub>1</sub>, X<sub>2</sub>, X<sub>3</sub> and Y<sub>1</sub> or Y<sub>2</sub> are not all oxygen lacks description and enablement. Please note that the gist of attorney's argument is that "...it is abundantly clear that those of ordinary skill in the art could have made all the compounds of claim 1 using only the original specification.....Applicant is of the opinion that the disclosure of a method of synthesizing the compounds of claim 1 wherein X and Y groups are oxygen is enabling for compounds wherein either nitrogen or sulfur are substituted for oxygen at one of all of the X and Y groups." Such mere arguments without factual evidence cannot obviate the rejection.

A search for the one or X or Y not being oxygen compounds of formula in claim 1 revealed that the literature is exclusively provided only X and Y are all oxygen compounds (see exhibit I attached), thus, starting material for the so alleged compounds wherein one or all X or Y is not oxygen is not found. Absent of starting material, one skilled in the art is offered mere language rather than enablement. Ex parte Moersch 104 USPQ 122. Further more, a search of the literature indicated while the X and Y are all oxygen core was recognized to have inhibition activity for the herpes virus (see CA 133:26483), no document of record provide any nexus for any X and Y are not oxygen compounds having such inhibiting activity.

A survey of the specification indicated exclusively only the X and Y are all oxygen compounds were synthesized and tested for herpes virus activity. Absent of any source and how to make the X or Y being non-oxygen compounds and absent of any nexus of such non-oxygen

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compound in biological activity with the X and Y are oxygen compounds, the mere argument by attorney can not refute the factual evidence in the prior art. That is, in absence of material thus, the X or Y are non-oxygen material for the method can not be available, and in absence of biological nexus, thus no dosage or method of treating herpes by an unavailable compound can be enabled.

**4. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

**5.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*OACS/Chang*  
*Jan. 8, 2006*

  
*Celia Chang*  
*Primary Examiner*  
*Art Unit 1625*